REMARKS

In the July 14, 2004 Office Action, the Examiner noted that claims 1-43 were pending in the application and rejected claims 1-43 under 35 USC § 103. In rejecting the claims, U.S. Patents 6,300,947 to Kanevsky; 6,305,399 to Agraharam et al.; 5,852,717 to Bhide et al. (References A-C, respectively, in the May 22, 2003 Office Action); and 6,029,182 to Nehab et al. (Reference A in the July 14, 2004 Office Action) were cited. Claims 1-43 remain in the case. The Examiner's rejections are traversed below.

Newly Cited Prior Art: U.S. Patent 6,029,182 to Nehab et al.

Nehab et al. patent is directed to a system for generating a custom formatted hypertext document by using data selected from a website using pre-determined criteria. The system includes the ability to convert the document from hypertext mark-up language (HTML) to rich text format (RTF).

Rejections under 35 USC § 103

On pages 2-12 of the Office Action, the Examiner rejected claims 1-4, 8-15, 17-23, 27-33, 35-39, 41 and 43 under 35 USC § 103(a) as unpatentable over Kanevsky in view of Nehab et al. As acknowledged in the first full paragraph on page 3 of the Office Action, Kanevsky "does not specifically teach converting at least a relevant part of requested information into response information in a type and format that can be utilized by the requesting terminal based on environment information for the requesting terminal." It was asserted that Nehab et al. teaches such conversion at column 13, lines 20-30 and column 24, lines 45-59. However, the cited portion of column 13 describes utility software, "WebFormatter," which "extracts data from a Web page, strips out ... extemporaneous data from the extracted data, and reformats the data into a formatted document ... in ... Rich Text Format" (column 13, lines 26-28), where it is assumed "extemporaneous" should be --extraneous--. The cited portion of column 24 is the introduction to "THE FORMATTER MODULE" in Appendix 3B. It clarifies that the module is intended to convert from hypertext mark-up language (HTML) to rich text format (RTF) which includes support for images in the following formats: DIP, DDB, WMF, and OS/2 and notes that since many web pages include GIF images, they will have to be converted to DIB format. Thus, the cited portions of Nehab et al., only describe a single type of conversion, from HTML used in a web page, to RTF used by word processing program, "such as MS Word, WordPerfect, Word Pad, etc." (column 13, lines 29-30), including the conversion of GIF files.

No suggestion has been cited or found in either Nehab et al. or Kanevsky of "determining whether conversion of requested information is necessary based on whether the requested information has a data format that can be utilized by the requesting terminal according to environment information for the requesting terminal" (e.g., claim 1, lines 5-7) or subsequently converting the requested information "when it is determined that the conversion of the requested information is necessary" (e.g., claim 1, lines 11-12) as described, e.g., on pages 8 and 9 of the application. All that Nehab et al. adds to Kanevsky is that it was known to be useful to convert HTML into a format that can be used by a word processing program. It is noted that Nehab et al. does not disclose how this could be done, since the "prototype" in Appendix 3B "creates a HTML file as the output" (column 24, line 57), not an RTF file. It is submitted that this is an insufficient teaching to suggest to one of ordinary skill in the art a method that includes the steps recited at lines 5-12 of claim 1 as amended herein.

Limitations similar to those quoted above in claim 1 have been added to independent claims, 14, 20, 37, 38 and 43, and the remaining independent claims, 32, 33, 39 and 41, already recited similar limitations. Therefore, it is submitted that claims 1, 14, 20, 32, 33, 37-39, 41 and 43, as well as claims 2-4, 8-13, 15, 17-19, 21-23, 27-31, 35 and 36 which depend therefrom, patentably distinguish over Kanevsky in view of Nehab et al.

On pages 12-13 of the Office Action, claims 5 and 24 were rejected under 35 USC § 103(a) as unpatentable over Kanevsky in view of Nehab et al. and Bhide et al. Furthermore, on pages 13 and 14, claims 6, 7, 16, 25, 26, 34, 40 and 42 were rejected under 35 USC § 103(a) as unpatentable over Kanevsky in view of Nehab et al. and Agraharam et al. The teachings added by the Bhide et al. and Agraharam et al. were discussed in the Amendment filed April 5, 2004. It is submitted that neither Bhide et al. nor Agraharam et al. teach or suggest modification of the combination of Kanevsky and Nehab et al. to overcome the deficiencies discussed above. Therefore, it is submitted that claims 5 and 24 patentably distinguishes over Kanevsky, Nehab et al. and Bhide et al. and claims 6, 7, 16, 25, 26, 34, 40 and 42 patentably distinguish over the combination of Kanevsky, Nehab et al. and Agraharam et al. for the reasons discussed above.

Summary

It is submitted that the references cited by the Examiner, taken individually or in combination, do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-43 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 10/14/04

By: Richard A. Gollhofer
Richard A. Gollhofer
Registration No. 31,106

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501